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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

10331.1/40176.64USC1

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on December 22, 2005Signature Diana C. AndersonTyped or printed name Diana C. Anderson

Application Number

10/756,877

Filed

January 13, 2004

First Named Inventor

Lon Richard Buske

Art Unit

2653

Examiner

Allen Heinz

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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Registration number 39,297☐

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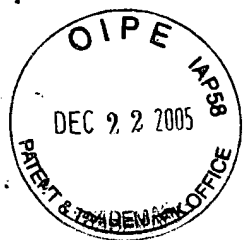
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NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

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PATENT
Dkt. 10331.1/40176.64USC1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **Lon Richard Buske, et al.**
Assignee: **SEAGATE TECHNOLOGY LLC**
Application No.: **10/756,877** Group Art Unit: **2653**
Filed: **January 13, 2004** Examiner: **Allen Heinz**
For: **SERVO TRACK WRITER WITH ACTUATOR VIBRATION
ISOLATION**

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**ACCOMPANYING ARGUMENTS FOR PRE-APPEAL
BRIEF REQUEST FOR REVIEW**

Sir:

This paper constitutes accompanying arguments for a pre-appeal brief request for review for the above identified U.S. patent application. A Notice of Appeal and a Pre-Appeal Brief Request for Review have been filed herewith.

Present Status of Claims

Pending claims 10, 13 and 16-21 are allowed. Pending claims 22-25 stand finally rejected under 35 U.S.C. §112, first paragraph, for failure to comply with the written description requirement. Claims 22-25 also stand finally rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,469,315 to Sanada ("Sanada '315"). A post-final clarifying amendment to claim 22 was proposed but not entered, and so this amendment does not form a portion of the present review.

Claim Language at Issue

Claim 22 is an independent method claim that generally features "*a track writing apparatus comprising a statically pressurized fluid bearing supporting a data transfer head relative to a storage medium.*" The phrase "statically pressurized fluid bearing" is at issue, both with regard to §112 and §102.

Summary of Arguments in Favor of Patentability

The Applicant respectfully submits that claim 22 is fully supported by the written description of the present application, and defines subject matter that is patentably distinct in view of Sanada '315. This can be readily demonstrated by the following points:

1. The written description discloses application of gas pressure to form a fluidic bearing for an actuator prior to rotational movement of the bearing. See e.g., specification, page 3, lines 25-28; page 12, line 28 to page 13, line 2; and Response filed November 29, 2005, page 5.

2. The test for whether the written description requirement is satisfied is whether the disclosure of the application reasonably conveys to the skilled artisan that the inventor had possession of the later amended claimed subject matter at the earlier time of filing. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555 (Fed. Cir. 1991); MPEP 2163.06. The specification “need not described the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the [filing] date the applicant had invented what is now claimed.” *Eiselstein v. Frank*, 52 F.3d 1035, 1038 (Fed. Cir. 1995)(emphasis added).

3. One having skill in the art would readily understand that the term “statically pressurized fluid bearing” as corresponding to the above description of item 1, in accordance with the legal standard of item 2 above. See 11/29/05 Response, pages 5-6.

4. The Examiner has failed to correctly apply the legal standard of item 2 in maintaining the rejection of 112, first paragraph, and maintains the query, “what is ‘static’ pressurization?” See final Office Action mailed September 29, 2005, page 2; Advisory Action mailed December 6, 2005.

5. It is incontrovertible that Sanada '315 discloses a dynamically pressurized fluid bearing wherein induced rotation of the actuator generates the pressurized bearing. See col. 2, lines 48-55 and 11/29/05 Response, page 5.

The Examiner maintains that he does not know what is claimed by claim 22, but nevertheless concludes that whatever it is, it is NOT disclosed in the specification of the present application, but it IS disclosed in Sanada '315.

Thus, the case is not ripe for appeal as the final rejection is without basis on the following grounds:

1. Clear legal error exists with regard to the written description requirement rejection; and
2. The Examiner has failed to establish a *prima facie* case of anticipation by Sanada '315 on the basis that Sanada '315 fails to disclose a statically pressurized fluid bearing, and instead clearly discloses a dynamically pressurized fluid bearing. See 11/29/05 Response, page 5.

Reconsideration of the final rejection and allowance of claims 22-25 are therefore respectfully solicited.

Respectfully submitted,

By: 

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